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David M. Sigmond
Sheridan Ross, PC
1560 Broadway
Suite 1200
Denver, CO 80202

In re Application of:
CARLSON et al
Serial No.: 09/224,202
Filed: December 30, 1998
For: DISK DRIVE WITH IMPROVED
TECHNIQUES FOR DETECTING
HEAD FLYING HEIGHT

DECISION ON PETITION UNDER 37
C.F.R. § 1.144 TO WITHDRAW A
RESTRICTION REQUIREMENT

This is a decision on the petition filed on August 7, 2000 under 37 C.F.R. § 1.144 to withdraw the restriction requirement set forth in the Office action mailed October 22, 1999, amended in the Office action mailed April 13, 2000 and made final in the Office action mailed July 28, 2000.

Claims 47-106 were subject to a requirement under 35 U.S.C. 121 to elect a single disclosed species, as being drawn to five patentably distinct species of the disclosed invention with no claim being generic thereto, the requirement having been made in an Office action mailed October 22, 1999. In response thereto, applicant elected the invention of claims 87-106, the election having been made in the response received November 10, 1999. In the Office action mailed January 18, 2000, the examiner held applicant's reply non-responsive on the grounds that applicant failed to specify which specie as exemplified by one or more drawing figures to which the elected claims were drawn. Subsequently, on February 15, 2000 the attorney filed a petition under 37 C.F.R. § 1.182 to withdraw the requirement to state to which specie the elected claims correspond. In the Office action mailed April 13, 2000, the examiner vacated the original requirement to elect a single species and substituted therefor a new requirement to elect one of nine patentably distinct species drawn to different enumerated sets of drawing figures, and deemed moot applicant's petition filed under 37 C.F.R. § 1.182. In response, applicant elected with traverse specie I, exemplified by drawing figures 8, 4 and 3, and claims 47-50, 53-79, 81-106, 108-113, 115, 118-123 and 125 (claims 105-126 having been newly added in an amendment filed April 10, 2000). In the Office action mailed July 28, 2000, the examiner repeated and made final the requirement to elect a single disclosed species, and further found that only claims 47-50, 53-58, 61-66, 87-88, 91-98, 101-106, 108-113, 115, 118-123 and 125-126 were drawn to the

elected specie, the remaining claims withdrawn from further consideration by the examiner as being drawn to non-elected species, 37 C.F.R. § 1.142(b).

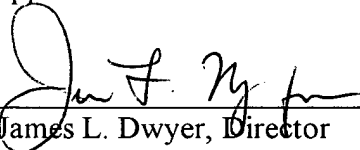
Petitioner argues that, with the amendment filed August 7, 2000, claims 87 and 97 are the only independent claims remaining in the case. Petitioner further argues that the examiner has failed to demonstrate a serious burden on the examiner as justification for requiring restriction, in that no showing of a separate classification, separate status in the art or a different field of search of the related yet distinct inventions has been made by the examiner. It appears that petitioner is arguing that, because the two independent claims have similar limitations, no serious burden on the examiner exists by the examination of all the pending claims. Such arguments are more appropriate for a restriction requirement made between inventions that are related to each other as outlined in MPEP § 806.05(c) – 806.05(i), rather than independent and patentably distinct species as disclosed and subject to the election requirement, as is noted in MPEP 808.02 referred to by petitioner. Petitioner's attention is directed to MPEP § **808.01(a) Species** which clearly states:

“Where there is no disclosure of relationship between species (see MPEP § 806.04(b)), they are independent inventions and election of one invention following a requirement for restriction is mandatory even though applicant disagrees with the examiner. There must be a patentable difference between the species as claimed. See MPEP 806.04(h). Since the claims are directed to independent inventions, restriction is proper pursuant to 35 U.S.C. 121, *and it is not necessary to show a separate status in the art or separate classification.*” [emphasis added]

Applicant's own specification discloses each “alternative embodiment” as exclusive of each other and hence independent, and therefore the claims directed to each embodiment are mutually exclusive, MPEP 806.04(f). Furthermore, as stated in MPEP 806, “Where inventions are independent (i.e., no disclosed relation therebetween), restriction to one thereof is ordinarily proper, MPEP § 806.04 - § 806.04(i), though a reasonable number of species may be claimed when there is an allowed (novel and unobvious) claim generic thereto. 37 CFR 1.141, MPEP § 809.02 - § 809.02(e).” The “no serious burden” argument is not persuasive since it is not a criterion for an election of species requirement between independent inventions. Furthermore, petitioner has not argued the examiner's statement that no claims are generic to all the disclosed species and thus is entitled to consideration of a reasonable number of species. Also, no generic claim has been indicated as allowable.

Accordingly, the petition is **DENIED.**

The application file is being forwarded to the examiner for preparation of an action responsive to applicant's terminal disclaimer and amendment filed August 7, 2000.


James L. Dwyer, Director
Technology Center 2600
Communications